UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,913	12/29/2001	Motoki Kato	450100-4414.1	9795

20999 7590 06/10/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER	
AN, SHAWN S	

ART UNIT	PAPER NUMBER
2613	15

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/032,913	KATO, MOTOKI	
	Examiner	Art Unit	
	Shawn S An	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 5/13/04 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/032,913 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. As per Applicants' instructions in Paper 14 as filed on 5/13/04, claims 18, 23, and 26-27 have been amended, and claims 1-17 have been canceled.

Response to Remarks

3. Applicant's arguments with respect to amended claims have been carefully considered but are moot in view of the new ground(s) of rejection incorporating double patenting and the previously cited prior art references.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 18, 23, and 26-27 are rejected under the judicially created doctrine of double patenting over claims 1, 3, 4, and 6 of U. S. Patent No. 6,393,114 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claims 18, 23, and 26-27 recite all as recited, as recited in patented claims 1, 3, 4, and 6, recite all. Therefore, the claims 18, 23, and 26-27 have been rejected in view of double patenting.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

6. Claims 19, 22, and 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, and 6 of U.S. Patent No. 6,363,114 B1 in view of Fukuda (5,949,956).

Regarding claims 19 and 24, The patent (6,363,114 B1) as described above fails to claim means for controlling an actual allocation data amount, so that a total of a bit amount generated when a signal of a time length which can be recorded on a recording medium is equal to or below a bit amount available in the recording medium for signal recording.

However, Fukuda teaches means for controlling the actual allocation data amount, so that a total of a bit amount generated when a signal of a time length which

can be recorded on a recording medium is equal to or below a bit amount available in the recording medium for signal recording (col. 6, lines 56-67 and col. 7, lines 1-23).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art employing the patent reference (6,363,114 B1) to incorporate the concept as taught by Fukuda as above as an efficient way to optimize or to control the bit rate allocation, thereby preventing the potential buffer overflow.

Regarding claim 22, The patent (6,363,114 B1) as described above fails to claim input signal being a moving picture image signal, and the coding difficulty is determined according to an image characteristic of the input image for each predetermined time and coding is carried out with an allocation data amount reflecting human visual characteristic based on the image characteristic information.

However, Fukuda teaches input signal being a moving picture image signal, and the coding difficulty (Fig. 2) is determined according to an image characteristic of the input image for each predetermined time and coding is carried out with an allocation data amount (102) reflecting human visual characteristic based on the image characteristic information.

Therefore, it would have been obvious to a person of ordinary skill in the relevant art employing the patent reference (6,363,114 B1) to incorporate the concept as taught by Fukuda as above as an efficient way to control the bit rate allocation based on the important image characteristics, such as human visual characteristic.

7. Claims 20-21, 25, and 28-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 4, and 6 of U.S. Patent No. 6,363,114 B1 in view of Chung et al (5,686,982).

Regarding claims 20-21, 25, and 28-29, the patent (6,363,114 B1) as described above fails to claim input signal being subjected to a pre-filter processing carrying out a low-pass filter processing to an input image when suppressing the actual allocation data amount below the reference value of the allocation amount data.

However, Chung et al teaches well known pre-filter means for a pre-filter processing (Fig. 3, 33), which includes a low pass filter for processing an input signal

(col. 5, lines 6-11).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art employing the patent reference (6,363,114 B1) to incorporate the concept as taught by Chung et al so as to utilize low pass filter as a pre-filter means when suppressing the actual allocation data amount below the reference value in order to prevent coding deterioration.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Shawn S An whose telephone number is 703-305-0099. The examiner can normally be reached on Flex hours (10).

9. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHAWN S. AN
PATENT EXAMINER

SSA
Primary Patent Examiner
6/9/04